

REMARKS

By this Amendment After Final, Applicants propose amending claims 15, 28, and 38 to more appropriately define the present invention. In addition, Applicants propose rewriting claims 19, 23, 29, and 33 in independent form to include all of the elements of each claim's base claim and any intervening claims, and amending claim 32 to correct its dependency. Claims 15, 17-23, and 28-38 are pending.

In the Final Office Action dated May 13, 2003, the Examiner rejected claims 15, 17-18, 22, and 38 under 35 U.S.C. § 102(e) as being anticipated by Fukuda et al. (U.S. Patent No. 6,329,991); rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of Willan (EP 0367405); and rejected claims 28, 35, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of Gengler (U.S. Patent No. 5,260,695).

The Examiner also objected to claims 19, 23, 29-34, and 37 as being dependent upon a rejected base claim, but indicated that they would be allowable if rewritten in independent form including all of the elements of each base claim and any intervening claims. Applicants thank the Examiner for the indication of allowable subject matter. Applicants propose rewriting claims 19, 23, 29, and 33 in independent form, placing these claims in *prima facie* condition for allowance. Claims 30-32, 34, and 37 should also be in condition for allowance due to their dependence from one of allowable claims 29 and 33. Therefore, Applicants respectfully request the Examiner to withdraw the objection and allow these claims.

Applicants respectfully traverse the rejection of claims 15, 17-18, 22, and 38 under 35 U.S.C. § 102(e) as being anticipated by Fukuda. To properly anticipate

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Applicants' claimed invention, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Applicants claim 15 recites "a game device for displaying . . . an object moving in accordance with developments of a game" including, among other things, "trace mark drawing means for drawing a trace mark in length within a predetermined range from said present position according to a movement of said object, said trace mark having a plurality of portions, and for gradually extinguishing said trace mark from a rear section of each portion by progressively making said rear section of each portion lighter in color toward a front section of each portion with lapse of time." Fukuda does not disclose at least these exemplary features of Applicants' claimed invention.

By contrast, Fukuda discloses a data processing method and apparatus that allows a user of a pen input device to input and output trace data. Specifically, Fukuda discloses an input/output electronic apparatus having a display with a digitizer; when a trace is input by a trace input pen, a resulting trace output is formed on the display (col. 2, lines 26-31; Fig. 2). As multiple traces are entered into the digitizer, Fukuda discloses that differences between new and old traces can be recognized in order to clarify the display and avoid confusing the user (col. 3, lines 49-52). Fukuda discloses

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that by changing the appearance of the entire trace, the user can distinguish between traces entered at different times (col. 3, lines 54-61, Fig. 9; col. 4, lines 24-33, Fig. 11).

In one embodiment, Fukuda discloses changing the brightness of the entire trace over time (col. 3, lines 42-44, Fig. 7, STEP 54). In another embodiment, Fukuda discloses varying the thickness of an entire trace over time (col. 4, lines 18-22, Fig. 10, STEP 84). Fukuda, however, fails to disclose or suggest a combination of elements, including at least “gradually extinguishing said trace mark from a rear section of each portion by progressively making said rear section of each portion lighter in color toward a front section of each portion with lapse of time,” as recited by claim 15.

The Examiner notes that Fukuda teaches “brightness, which is one display attribute of the trace 21 which has already been drawn, is changed to a lower value” (col. 2, lines 53-55). However, Applicants respectfully disagree that this teaching anticipates Applicants’ claimed invention. More particularly, Applicants note Fukuda next explains that trace 21 is changed to appear as trace 31, which is depicted in Figure 5 (col. 2, lines 55-56). In Figure 5, trace 31 is depicted as a uniform dotted line with the same brightness level for the entire trace. Therefore, trace 31 is displayed with a uniform brightness that is less than the brightness of trace 32 (Figure 5).

Moreover, Applicants note that Fukuda teaches using a pen input device for manual input of user information. By contrast, Applicants’ claimed invention recites “a game device for displaying . . . an object moving in accordance with developments of a game.” Accordingly, for at least the above reasons, Applicants respectfully request the Examiner to withdraw the rejection of claim 15. Claims 17, 18, and 22 depend from

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claim 15 and are allowable for at least the reasons described above for allowable claim 15.

Additionally, claim 38 recites a combination including, among other things, "gradually extinguishing said trace mark from a rear section of each portion by progressively making said rear section of each portion lighter in color toward a front section of each portion with lapse of time." As discussed above in connection with claim 15, Fukuda does not disclose at least these exemplary features of Applicants' claimed invention. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 38.

Applicants respectfully traverse the rejection of claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of Willan. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

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Claims 20 and 21 depend from claim 15 and thus include all of the recitations thereof. As discussed above, Fukuda does not teach or suggest all of the features recited in claim 15. In addition, Willan does not cure the deficiencies of Fukuda.

Willan teaches a computer graphics system having an input device and a means for detecting changes in the position of the input device relative to a surface (col. 1, lines 41-44). Willan further teaches a means for determining at least one derivative with respect to time of the input device position, and controlling characteristics of displayed patterns based upon the derivative (col. 1, lines 47-51).

Fukuda and Willan, either separately or in combination, fail to teach or suggest a combination of elements including, at least, "gradually extinguishing said trace mark from a rear section of each portion by progressively making said rear section of each portion lighter in color toward a front section of each portion with lapse of time," as required by claims 20 and 21.

Furthermore, Applicants respectfully disagree with the alleged motivation put forth by the Examiner for modifying Fukuda with the teachings of Willan. The Examiner alleges that Willan "teaches the trace could be affected by the drawing speed in order to make the trace visually more effective" (Office Action, page 5). However, this teaching does not disclose or suggest at least "gradually extinguishing said trace mark from a rear section of each portion by progressively making said rear section of each portion lighter in color toward a front section of each portion with lapse of time," as recited in claims 20 and 21. Instead, Willan teaches using velocity and acceleration of the input device to express features such as "jerky" movements when displaying the user's input (col. 2, lines 14-14).

Moreover, Fukuda merely teaches creating a visual track that outlines a path of an input pen over a digitizer (co. 2, lines 39-42, Fig. 3). Fukuda is thus directed toward inputting user drawn lines whereas Applicants' claimed invention is directed toward "a game device for displaying . . . an object moving in accordance with developments of a game" to display realistic images. Additionally, there would be no reasonable expectation of success arising from incorporating the teachings of Willan into Fukuda since both fail to teach or suggest all of the elements included in claims 20 and 21.

Accordingly, for at least the above reasons, Applicants respectfully request the Examiner to withdraw the rejection of claims 20 and 21.

Applicants respectfully traverse the rejection of claims 28, 35, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of Gengler.

Claim 28 recites a combination including, among other things, "gradually extinguishing said trace mark from a rear section of each portion by progressively making said rear section of each portion lighter in color toward a front section of each portion with lapse of time," "first storage means for storing said trace mark after said game ends," and "read out means for reading from said first storage means said trace mark that is stored in the first storage means before a beginning of said game and for providing said trace mark as said past trace mark to said processing and displaying means." Fukuda or Gengler, taken alone or in combination, do not disclose or suggest at least these exemplary features of Applicants' claimed invention.

As previously discussed, Fukuda does not disclose all of the features of Applicants' claimed invention. Moreover, Gengler does not make up for the deficiencies of Fukuda. Gengler discloses a method and apparatus for subdividing a frame buffer,

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along window plane boundaries, into multiple images that are processed through independent color maps and blended into a single image on arbitrary window boundaries (col. 2, lines 56-62). A window refers to a region of interest in the frame buffer (col. 1, lines 62-64). The image processing provides, for example, real-time fading of one image into another or fading out an entire image (col. 5, lines 40-45). Gengler, however, does not disclose or suggest at least the exemplary features of Applicants' claimed invention.

In addition, the Examiner has not provided a motivation for making the proposed combination and instead only concludes it would have been obvious to incorporate the teachings of one reference into the other (Office Action, page 6). Applicants respectfully disagree with the Examiner's allegations and conclusions. Fukuda is directed to displaying user inputted lines draw by a pen. Because Fukuda is directed to user input drawn by a pen device, it would not be obvious or appropriate to incorporate the image processing system for blending and fading elaborate image features as disclosed by Gengler into Fukuda. Nor has the Examiner provided a reasonable expectation of success to incorporate the teachings of Gengler into Fukuda.

Accordingly, for at least the above reasons, the Examiner should withdraw the rejection and allow claim 28. Claim 35 depends from claim 28 and is allowable for at least the reasons described above for allowable claim 28. Claim 36 multiply depends from independent claims 15, 28, 29, and 33, which are allowable for reasons set forth above, as well as dependent claims 17, 18, 30-32, 34, and 35, which each depend from one of those independent claims.

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Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing claims 15, 17-23, and 28-38 in condition for allowance. Applicants submit that the proposed amendments of claims 15, 17-23, and 28-38 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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